

Application No. 10/798,052  
Preliminary Amendment "B"

### REMARKS

By this paper, various of the existing claims have been amended, no claims have been cancelled, and claims 28-42 have been added. In view of the amendments to the claims and the following remarks, Applicant respectfully requests reconsideration and allowance.

The Examiner rejected claims 1-4, 6-12, 14-19, 21-25 and 27, as being anticipated by Williams, U.S. Patent No. 6,089,163 ("Williams"). Specifically, the Examiner stated that Williams discloses "a device for grabbing a rail panel and lifting it, comprised of a frame capable of being mounted on a pair of parallel rails. ... As shown in figure 9 the lifting frame is shown mounted on the rear of a piece of heavy equipment, in this case a backhoe. The backhoe operator can move the frame into place and operate the hydraulic cylinder on the frame to grip the rails and lift the desired section and transport the section." (See page 2 of office action).

Williams, however, is directed to a device for "adjusting the separation distance between adjacent rails." See Abstract. The backhoe 300 of Williams "serves as the vehicle for mounting of the rail gripper." (Williams Patent, 7:25-27). As further support for this stated purpose, shown in Figure 9, the backhoe 300 is situated on top of the rails R and R'.

As opposed to Williams, the present invention is directed to a device for grabbing and lifting an entire rail panel, not merely to aligning one rail with respect to another. The device of the present invention can also be configured to grab a rail panel at different locations along the length of the rail panel, rather than contacting merely a single location. The device also has a rotator for rotating the rail panel once the rail panel has been lifted. Many other advantages of the present invention are also disclosed in the application.

Independent claim 1 has now been amended to claim a device for grabbing a rail panel having a first and a second spaced apart rail, the first rail being parallel to and linked to the

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second rail. Thus, it is clear that claim 1 claims a grabbing device that grabs an entire rail panel, i.e., a panel comprising a first rail linked to a second rail, not merely a device that aligns a single rail or a device that moves a first rail with respect to a second rail. The present invention has a significant advantage of being able to replace an entire rail panel of a damaged portion of railroad track by moving an entire new rail panel onto a selected location, as illustrated in Figure 10. Thus, one advantage of the present invention is the ability of the invention to grab and move an entire rail panel, not merely a single rail. Therefore, claim 1 is not anticipated by or obviated by Williams.

Furthermore, claim 1 claims that "the rail panel can be lifted by lifting the grabbing device" while the Williams' device adjusts separation distance between rails.

Claim 10 has been amended to claim that when said hydraulically operated elements are actuated, said first and second pluralities of hydraulically operated elements contact the rail panel at different locations along the length of the rail panel." The newly-added structural language of claim 10, *inter alia*, allows the device of the present invention to be conveniently and firmly fixed to the rail panel at different locations along the length of the panel, rather than at a single location along the length of the rail panel.

By contrast, the device of Williams only discloses a single boom or arm and telescoping members that cooperate at only a single location along the length of the rails. Williams does not disclose elements that contact rails at different locations along the length of the rails. Such would obstruct the purpose of Williams. As shown in the figures of Williams, there is only one assembly contacting one location along the length of the rails R and R' at a time to accomplish the goal of adjusting separation distance. (See, e.g., Figs. 1 and 9 of Williams Patent).

Claim 24 claims a first plurality of moveable elements coupled to a first end of the frame

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and a second plurality of moveable elements coupled to a second end of the frame, whereas the Williams reference fails to disclose the use of such pairs of moveable elements.

The Examiner also rejected claims 5, 13, 20 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Williams in view of Young et al, U.S. Patent No. 5,191,839 ("Young"). In light of the amendments to the claims described above Applicant submits that the § 103(a) rejections are rendered moot.

Further, as a result of the amendments to independent claims 1, 10, 16 and 24, which further clarify the invention, it is clear that Williams does not render them obvious because since Williams was directed to a different purpose, the Applicant would have had less motivation or occasion to consider it:

[T]he purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve. If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. **If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.**

*In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992) (emphasis added). As set forth above, Williams has a different purpose than the present invention. One purpose of the present invention is to lift and transport a rail panel, whereas the purpose of the device of Williams is to adjust the "separation distance between adjacent rails." (Williams Patent, Abstract).

The amendments herein have a basis throughout the original specification, claims, and drawings, including original Figures 3, 4A-4B, and 8.

Thus, Applicant respectfully submits that all pending claims are now in condition for allowance. In the event that the Examiner finds remaining impediment to a prompt allowance of

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this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 1st day of June, 2006.

Respectfully submitted,



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